

II. REMARKS

A Final Office Action was issued in this application on November 14, 2008 (hereinafter “Final Office Action”). The Final Office Action and the references cited therein have been carefully reviewed; this submission is believed to be fully responsive to the Final Office Action. Claims 1-13 are pending in the application. Claims 1-3, 5 and 7-10 currently stand rejected, whereas claims 4, 6 and 11-13 are objected to by the Examiner. Applicants have amended claims 1 and 7. After entering this submission, claims 1-13 remain pending. Reconsideration and allowance of this application in view of the above amendments and the following remarks is respectfully requested.

A. EXAMINER’S RESPONSE TO ARGUMENTS

Applicants have reviewed the Examiner’s “Response to Arguments” section, and acknowledge that the amendments and remarks submitted in Applicants’ “Amendment under 37 C.F.R. § 1.111”, entered on August 5, 2008 (hereinafter “Second 1.111 Amendment”), overcome the previous objections to claims 1 and 8, the 35 U.S.C. § 112, second paragraph, rejections of claims 1-6 and 9-13, and the double patenting rejections of claims 9, 10 and 13. See Final Office Action, at 3, Item No. 5. In addition, Applicants’ remarks with respect to the § 102(b) rejections of claims 1-3, 5 and 7-10, see Second 1.111 Amendment, § II.E, at 6-8, have been evaluated by the Examiner, but are not believed to be persuasive. See Final Office Action, at 3, Item No. 5.

B. CLAIM REJECTIONS – 35 U.S.C. 102

Claims 1-3, 5 and 8-10 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent Appl. Publication No. 2002/0171258 A1, to Obendiek (hereinafter “Obendiek”). In response, Applicants have amended claim 1. Conversely, Applicants respectfully traverse the rejection as it pertains to claims 8-10.

The Examiner collectively rejects independent claims 1 and 8 under § 102(b) on the premise that the Obendiek reference discloses, in part, “a holding device 1 that can be mounted on the auto body, which is also a support for at least one control unit 9, a hydraulic pump 10 and inherently connections of control lines leading to drive units for roof movement.” Final Office Action, at 2, Item No. 2 (emphasis added). In response to the pending 102(b) rejection, base claim 1 has been amended to more clearly indicate how the subject matter originally presented

therein is patentably distinguishable from the prior art of record. On the other hand, Applicants respectfully traverse the 102(b) rejection of base claim 8, and any claims depending therefrom, as inappropriate since the prior art of record does not properly anticipate the subject matter presented therein.

According to MPEP standards and judicial requirements, “[a]nticipation requires the presence in a single prior art disclosure of all elements of a claimed invention arranged as in the claim.” Soundsciber Corp. v. U.S., 360 F.2d 954, 960 (Ct.Cl. 1966). Specifically, “[i]nvalidity on the ground of ‘anticipation’ requires lack of novelty of the invention as claimed ... that is, all of the elements and limitations of the claim must be shown in a single prior reference, arranged as in the claim.” Karsten Manufacturing Corp. v. Cleveland Golf Co., 242 F.3d 1376, 1383 (Fed. Cir. 2001) (Emphasis added).

It is not sufficient that a reference ostensibly appears to illustrate an applicant’s invention. See MPEP § 2131. Rather, for anticipation purposes, “[t]he identical invention must be shown in as complete detail as is contained in the ... [rejected] claim.” Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236 (Fed. Cir. 1989). In other words, “the prior art reference - in order to anticipate under 35 U.S.C. § 102 - must not only disclose all elements of the claim within the four corners of the document, but must also disclose those elements arranged as in the claim.” Net MoneyIn, Inc. v. Verisign, Inc., 2007-1565 (Fed. Cir. Oct. 20, 2008) (Citation in original omitted. Emphasis added.)

With respect to independent claim 1, Applicants have amended the invention presented therein to clarify that the holding device “is configured to be mounted on the auto body and support at least one control unit (12), a hydraulic pump (16) and connections (14) of control lines (21) leading to drive units (4) for roof movement.” (Emphasis provided to highlight language added by amendment.) The proposed amendment to claim 1 does not introduce new matter into the subject application, the amendment being properly supported, for example, by Figs. 2-5 of the drawings, and paragraphs [0024]-[0025] of Applicants’ originally presented specification. In addition, the language added to claim 1 is merely an extension upon Applicants’ prior submission, included solely to clarify previously discussed limitations. Therefore, the amendment to claim 1 does not raise new issues requiring further search or consideration, and thus only warrants a cursory review by the Examiner. See MPEP 714.13(I)-(II).

Independent claims 1 and 8 each recite at least one element that is not fully anticipated by the Obendiek reference. In particular, claim 1 recites a holding device, shown in an exemplary embodiment at 9 in Fig. 4, that is “configured” – i.e., “designed, arranged, or shaped”, The American Heritage Dictionary of the English Language, Houghton Mifflin Company (4th Ed. 2006), “to be mounted on the auto body and to support at least one control unit (12), a hydraulic pump (16) and connections (14) of control lines (21) leading to drive units (4) for roof movement.” These characteristics are not recited merely as the intended use of the claimed “holding device”, but are positively recited structural limitations material to patentability. See Hoffer v. Microsoft Corp., 405 F.3d 1326 (Fed. Cir. 2005) (The court held that a “clause [which] states a condition that is material to patentability ... cannot be ignored in order to change the substance of the invention.” Id., at 1329.) Claim 8 recites similar patentably distinguishable elements and limitations to those highlighted above with respect to claim 1.

In contrast to Applicants’ claimed holding device, Obendiek’s holding device, identified by the Examiner as main bearing 1, is not configured to support: (a) at least one control unit; (b) a hydraulic pump; and (c) connections of control lines that lead to drive units for roof movement. Notably, the Examiner has erroneously identified Obendiek’s hydraulic cylinder 10 as “a hydraulic pump” and linkage 9 as “a control unit”. More importantly, the Examiner has still failed to provide any extrinsic evidence on the record to maintain the contention that Obendiek’s main bearing 1 “inherently” supports “connections of control lines leading to drive units for roof movement”. If the Examiner is to rely on the theory of inherency, the Examiner must provide a basis in fact “to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” Ex parte Levy, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). Accordingly, Obendiek is insufficient prior art upon which to maintain a 102(b) rejection of claims 1 and 8, or any claims respectively depending therefrom.

The Obendiek reference also fails to anticipate pending claims 2, 3, 9 and 10. That is, Obendiek does not anticipatorily depict or describe the main bearing 1 as being “configured to be preinstalled outside of the auto body and checked for function of both the at least one drive element (8) for the cover part (7) and the drive units (4) for moving the roof”, as similarly set forth in claims 2 and 9. Rather, Obendiek’s frame element 3, hydraulic cylinder 10, and main links 9a are rendered completely inoperable when the main bearing 1 is outside of the vehicle.

Moreover, Obendiek's main bearing 1 is not "configured to be installed in a side receptacle of the auto body in front of or behind a wheel well (10)", as similarly required by claims 3 and 10.

Remarkably, the Examiner has completely failed to address any of the limitations presented in claims 2, 3, 9 and 10, let alone indicate where in the prior art of record such limitations may be found, in violation of MPEP standards and Federal regulations. The Code of Federal Regulations establishes the requisite content for an office action. This mandate, as it pertains to the rejection of claims, is explicated in 37 C.F.R. § 1.104(c)(2), which states, *inter alia*, "[i]n rejecting claims for want of novelty or for obviousness, the ... pertinence of each reference ... must be clearly explained" (Emphasis added). MPEP directives similarly require an examiner to "clearly articulate any rejection ... so that the applicant has the opportunity to provide evidence of patentability and otherwise reply completely" MPEP 706. As recently demonstrated by the U.S. Court of Appeals for the Federal Circuit in In re Buszard et al., the failure to properly articulate a rejection, through evidence and argument on the record, thereby denying an applicant an opportunity to refute the rejection, is grounds for reversing an examiner's rejection. 84 USPQ2d 1749 (Fed. Cir. 2007). As such, the pending 102(b) rejection should, at a minimum, be withdrawn in favor of a fully articulated rejection in compliance with MPEP and CFR directives.

In view of the preceding amendments and corresponding remarks, Applicants respectfully request reconsideration and withdrawal of the § 102(b) rejection of claims 1-3, 5 and 8-10 based upon the Obendiek reference.

Claim 7 is rejected under 35 U.S.C. § 102(b) as being anticipated by International (PCT) Appl. Publication No. WO 2002/43978 A2, to Rawlings et al. (hereinafter "Rawlings"). In response, Applicants have amended claim 7.

In order to reject independent claim 7, the Examiner finds that Rawlings discloses "a multifunctional holding device 32" which meets all of the limitations of Applicants' claimed holding device. See Final Office Action, at 2-3, Item No. 3. On page 8 of the Second 1.111 Amendment, Applicants' noted that the Examiner has not indicated where in Rawlings the body-mounted mounting bracket 32 is disclosed as having "several connection flanges" that "accommodate" at least one control unit, a pump, and connections for emerging hydraulic lines, in addition to being characterized "as a support for at least one drive element [] for a cover part []

of a compartment top of a convertible vehicle”, as required by previously presented claim 7. In response, the Examiner indicates that “a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art.” Final Office Action, at 4, Item No. 7. In response to the pending 102(b) rejection, base claim 7 has been amended to more clearly indicate how the subject matter originally presented therein is patentably distinguishable from the Rawlings reference.

Claim 7 is amended herein to clarify that the multifunctional holding device (9) includes “several connection flanges (11, 13, 15, 17) each configured to support at least one of a control unit (12), a pump (16), and connections (14) for emerging hydraulic lines (21)”. (Emphasis added to highlight language inserted by amendment.) The proposed amendment to claim 7 does not add new matter to the subject application, the amendment being properly supported, for example, by Figs. 2-5 of the drawings, and paragraphs [0024]-[0025] of the specification. In addition, the language added to claim 7 is merely an extension upon Applicants’ prior submission, included solely to clarify previously discussed limitations. Thus, the amendment to claim 7 does not raise new issues requiring further search or consideration, and thus only warrants a cursory review by the Examiner.

Rawlings does not anticipate amended claim 7. The mounting bracket 32 does not includes an array of connection flanges, each of which is configured to support a control unit, a pump, and/or connections for emerging hydraulic lines. Rawlings’ mounting bracket 32 includes a single flange for supporting control arm 34 and rear rail 22. Applicants have reviewed the entire Rawlings reference, and were unable to locate a single recitation or depiction of a control unit, a pump, connections for emerging hydraulic lines, or similar structure, let alone a holding device that has “several connection flanges ... each configured to support” such structure. Consequently, Rawlings is not proper prior art for rejecting amended claim 7 under Section 102 of Title 35.

In light of the amendment and remarks presented above, Applicants request reconsideration and withdrawal of the § 102(b) rejection of amended claim 7 based upon the Rawlings reference.

C. ALLOWABLE SUBJECT MATTER

Claims 4, 6 and 11-13 are deemed “allowable if rewritten ... to include all of the limitations of the base claim and any intervening claims.” Final Office Action, at 3, Item No. 4.

Applicants respectfully submit, however, that claims 4 and 6 and claims 11-13 are allowable for at least those reasons as independent claims 1 and 8 set forth hereinabove, *supra* § II.B, at 5-9, from which they respectively depend.

III. CONCLUSION

In light of the foregoing amendments and remarks, this submission is believed to be fully responsive to the Final Office Action, dated November 14, 2008. The amendments and remarks in support of the rejected claims are believed to place this application in condition for allowance, which action is herein respectfully requested. If the Examiner believes that a personal conference with Applicants' attorney will help expedite prosecution of the captioned application, the Examiner is respectfully invited to contact the undersigned at her soonest convenience via the correspondence options provided below.

Respectfully submitted,

MARIAN DANIEL BAUM et al.

By: 

Christopher W. Quinn
Reg. No. 38,274

Date: 1/6/09

QUINN LAW GROUP, PLLC
39555 Orchard Hill Place, Suite 520
Novi, Michigan 48375
Phone: 248-380-9300
Fax: 248-380-8968